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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09 882,241	06/15/2001	Robert C. Schmidt JR.	1933.BDM	1360

7590 06/25/2003  
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EXAMINER

RIBAR, TRAVIS B

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 06/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/882,241

Applicant(s)

SCHMIDT ET AL.

Examiner

Travis B Ribar

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3, 4
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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### **DETAILED ACTION**

1. The amendment filed April 9, 2003 overcomes the rejections put forth in paragraphs 2-5, 9, 13, 15, 18, and 21 of the previous office action.
2. The examiner maintains all other rejections found in the previous office action.

### ***Claim Rejections - 35 USC § 112***

3. The amendment filed April 9, 2003 overcomes all rejections put forth in the previous office action under this heading.

### ***Specification***

4. The amendment filed April 9, 2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

The examiner is unsure whether the amendment to the table on page 14 is supported by the original disclosure of the invention.

Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Claim Rejections - 35 USC § 102***

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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6. Claims 1-2, 4, 6-8, 10, and 12-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Wolinski.

The office action dated November 1, 2002 contains the text of this rejection. Regarding the newly added limitation that the acrylic is hydroxyl functional, the examiner notes that the acrylic in Wolinski (column 7, lines 1-8) meets this limitation.

***Claim Rejections - 35 USC § 103***

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claims 5 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolinski in view of Yang et al.

The office action dated November 1, 2002 contains the text of this rejection. Regarding the newly added limitation that the acrylic is hydroxyl functional, the examiner notes that the acrylic in Wolinski (column 7, lines 1-8) meets this limitation.

9. Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Helmeke et al. in view of Wolinski.

The office action dated November 1, 2002 contains the text of this rejection. Regarding the newly added limitation that the acrylic is hydroxyl functional, the examiner notes that the acrylic in Wolinski (column 7, lines 1-8) meets this limitation.

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10. Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolinski in view of Helmeke et al.

The office action dated November 1, 2002 contains the text of this rejection. Regarding the newly added limitation that the acrylic is hydroxyl functional, the examiner notes that the acrylic in Wolinski (column 7, lines 1-8) meets this limitation.

11. Claims 1-4, 6-10, and 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolinski in view of Markevka et al.

The office action dated November 1, 2002 contains the text of this rejection. Regarding the newly added limitation that the acrylic is hydroxyl functional, the examiner notes that the acrylic in Wolinski (column 7, lines 1-8) meets this limitation.

12. Claims 5 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolinski in view of Markevka et al. as applied to claims 1-4, 6-10, and 12-13 above, and further in view of both Yang et al. and Helmeke et al.

The office action dated November 1, 2002 contains the text of this rejection. Regarding the newly added limitation that the acrylic is hydroxyl functional, the examiner notes that the acrylic in Wolinski (column 7, lines 1-8) meets this limitation.

13. Claims 1-4, 6-10, and 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolinski in view of Shimizu.

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The office action dated November 1, 2002 contains the text of this rejection.

Regarding the newly added limitation that the acrylic is hydroxyl functional, the examiner notes that the acrylic in Wolinski (column 7, lines 1-8) meets this limitation.

14. Claims 5 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolinski in view of Shimizu as applied to claims 1-4, 6-10, and 12-13 above, and further in view of both Yang et al. and Helmeke et al.

The office action dated November 1, 2002 contains the text of this rejection.

Regarding the newly added limitation that the acrylic is hydroxyl functional, the examiner notes that the acrylic in Wolinski (column 7, lines 1-8) meets this limitation.

### ***Response to Arguments***

15. Applicant's arguments, see the response filed April 9, 2003, with respect to Yang et al. not including hydroxyl functional acrylics, as the newly amended claims call for, have been fully considered and are persuasive. Those rejections which used Yang et al. to show this aspect of the invention have been withdrawn.

16. The applicant argues that Wolinski does not anticipate the current claims because Wolinski discloses a two-part adhesive instead of a one-part adhesive. The applicant also argues that the combination of the references the examiner used also lead to two-part adhesives and therefore do not anticipate or render obvious the current

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claims. The current claims, however, do not call for a one-part adhesive, so this limitation cannot be relied upon to overcome the applicability of the reference.

17. The applicant also argues that there is no motivation to combine Helmeke and Wolinski (rejection of claims 1-13) and that the two references should not be combined because of differences in the applications of the adhesives that each of them teach. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation for adding the reactive acrylic material found in the adhesive in Wolinski to the adhesive in Helmeke would be to improve the cure time and the strength of the adhesive.

In response to applicant's argument that Helmeke and Wolinski are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, both references are drawn to adhesive compositions.

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18. The applicant argues that Markevka et al. discloses a hot melt adhesive blend and therefore teaches away from the applicant's adhesive and that combining it with Wolinski would lead to a two-part adhesive. The argument regarding the two-part adhesive is addressed above. Similarly, the current claims do not exclude an adhesive blend and therefore this limitation cannot be relied upon to overcome the reference.

19. The applicant also argues that Shimizu is not applicable to the present invention because it requires the presence of a crystalline monomer and because it requires clamping during use, whereas the applicant's adhesive requires none of those limitations. This is not persuasive because the current claim language does not preclude such limitations and therefore these limitations cannot be relied upon to overcome the reference.

### ***Conclusion***

20. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of



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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

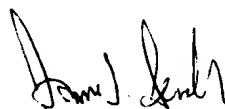
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Travis B Ribar whose telephone number is (703) 305-3140. The examiner can normally be reached on 8:30-5:00 Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (703) 308-2462. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Travis B Ribar  
Examiner  
Art Unit 1711

TBR  
June 19, 2003



James Seidleck  
Supervisor, Art Unit 1711  
Examiner